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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,768	07/24/2001	Kenkou Yamaura	31721-174066	3574

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EXAMINER

LE, KHANH H

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/910,768	Applicant(s) YAMAURA, KENKOU	
	Examiner Khanh H. Le	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/10/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to Amendment dated 2/14/2005. The amended specifications are entered. Claims 5-7 are pending. The previous rejections are withdrawn as moot following cancellation of claims 1-4.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

As to claims 5 and 7, the preamble claims a method while the body of the claim claims system elements “means”, thus the scope of the claims is unclear. Appropriate correction is required.

Further, “addressee” in “means for saving said lottery number and said addressee to a file..” leads to confusion. Earlier a “recipient” and an “addressee mail address of the recipient” had been mentioned. It is unclear what “addressee” in the above mentioned phrase mean in this context: the email address of the recipient? or the recipient? Also, as drafted, “said addressee” lacks proper antecedent. Appropriate correction is required.

Regarding claim 6, the phrase “such as” (“such as the e-mail address, nickname, etc.”) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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Further “sending mail server settings within said terminal device are rewritten with the mail server of said server device” is incomprehensible and thus no prior art can be applied to this limitation as there is substantial doubt as to the scope of this limitation.

As to claim 7, “making accessing” is colloquial and creates confusion . Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by SUGIMOTO HIDEO et al, JP 11-242714.**

SUGIMOTO discloses an advertisement method , whereby a sender sends to a receiver an electronic greeting card and the system automatically inputs both the sender and the receiver to a lottery for a free gift selected by the sender (Fig 4, S310). Plural options of gifts are offered, one of which is that the gift is not to be received by the sender. The sender is requested to fill out a questionnaire before generating and sending a first greeting card. Participants can check whether or not they acquire the free gift.

Thus as to claim 5, SUGIMOTO explicitly and /or implicitly discloses:

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a homepage access system and method using lottery numbered e-mails (greeting cards) , said method being used for accessing a server device having a homepage for providing a mail sending/receiving service to a terminal device such as a personal computer over a network, said server device comprising:

means for starting up a mailer of said server device by said terminal device accessing said homepage and a sender clicking on a predetermined button on said homepage (see at least Figs.2 and associated text)

means for instructing that the sender will create an e-mail by the start up of said mailer (see at least Figs.2-3 and associated text);

means for determining the suitability of the e-mail upon completion of creating the e-mail (see at least Figs: 11, item 806 and associated text : a card cannot sent to and from a same address);

means for writing at the end of the e-mail a lottery number (see at least Figs. 17 and associated text) and an address of said homepage (see at least Figs.13-14 and associated text; see at least page 20 last paragraph);

and further attaching a notification of a drawing thereto and sending the e-mail to the addressee mail address of the recipient, in the event that said determining means determines the e-mail to be suitable;

means for saving said lottery number and said addressee to a file within the server device at the time of sending the e-mail to the e-mail recipient (see at least Figs. 3, database 127; Fig.15 and associated text);

means for performing processing for randomly determining a winning lottery number from said saved lottery numbers (see at least page 17 4th full paragraph); and

means for matching an e-mail address input by said e-mail recipient with the lottery number and addressee e-mail address of said e-mail recipient saved in said file, in the event that said e-mail recipient accesses the address of said homepage written in the sent e-mail and checks winning of the lottery number, so as to check the identification of a winner (see at least Figs. 3 and 15 and associated text) .

As to claim 7, SUGIMOTO discloses wherein said server device has an original mailer set so as to be capable of accessing said homepage for sending/receiving e-mails, said server device comprising:
means for displaying a mailer download screen upon said terminal device making accessing for an original mailer download request, instructing input of required items, and registering the necessary items in a user registration file upon completion of input of the required items, and downloading said original mailer (see at least Fig. 1 and associated text).

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over SUGIMOTO.

As to claim 6, SUGIMOTO explicitly or at least implicitly discloses wherein, upon a user registration request from said terminal device, said server device displays a user registration screen and instructs input of required items **such as** the e-mail address of the user; and wherein, upon the user making input according to said instructions, said required items are stored in a user registration file (see at least Figs 1-5 and associated text).

As to “the user of said registration request is provided with a nickname, and the user of said registration request is notified of the nickname.” SUGIMOTO does not specifically disclose these. However, Official Notice is taken that these steps are well-known and practiced in case a nickname is desired to be used. It would have been obvious to one skilled in the art at the time the invention was made to add the above well-practiced steps to SUGIMOTO to implement the process as is ordinarily done in case a nickname is desired to be used.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 30, 2005

KHL

KHL


JAMES W. MYHRE
PRIMARY EXAMINER